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MAY 22 1963

No. 1087

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962.

SHAW-BARTON, INC.,
Petitioner,

vs.

JOHN BAUMGARTH CO., INC.,
Respondent.

On Petition For A Writ of Certiorari
To The United States Court of Appeals
For the Seventh Circuit

BRIEF OF RESPONDENT IN OPPOSITION

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The Scheffer Press, Inc.—ANdover 3-6850

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The Petition fails to set forth any "special and important" reasons why it should be granted, as required by rules of this Court.

STATEMENT

This litigation involves the question of the validity as a trademark of the term "Homemakers" or "Homemakers Calendar" as applied to kitchen calendars of the type filled with editorial matter of interest to a housewife in the management of the home—a homemaker.

The Court of Appeals held that the term is descriptive of the specific type of calendar here involved, particularly in this industry wherein titles are used for different calendars to designate their editorial content, such as the titles "Catholic Church" calendar, "Jewish Home" calendar, "Protestant" calendar, and "Lutheran" calendar. The Court of Appeals noted that Petitioner conceded that those names are not subject to being trademarked. The Court also found that the term "Homemaker" had not acquired a secondary meaning.

REASONS FOR DENYING THE WRIT

THERE ARE NO SPECIAL AND IMPORTANT REASONS FOR GRANTING THE WRIT

The decision in this case is of very narrow importance —it is limited to (a) the particular term "Homemakers", (b) as applied to one particular type of calendar, (c) in an industry wherein names are applied to calendars determined by the editorial content thereof and are recognized as not subject to being trademarked. There is nothing "special" about this case, nothing of general "importance". No new principles of law are involved. The issue in this case is of importance only to the parties in this suit.

THE DECISION IS IN CONSONANCE WITH THE DECISIONS OF THIS COURT

The decision of the Court of Appeals turned on the simple issue of whether or not the word "homemakers", as applied to the type of calendars here in issue, is descriptive of those calendars. The test of descriptiveness, within the meaning of trademark law, has been repeatedly announced by this Court. *Standard Paint Co.* v. *Trinidad Asphalt Mfg. Co.*, 1911, 220 U.S. 446, 453, 454; *Warner*

and Co. v. *Eli Lilly and Co.*, 1924, 265 U.S. 526, 528. In the latter case, this Court stated (p. 528):

> "A name which is merely descriptive of the ingredients, qualities, or characteristics of an article of trade cannot be appropriated as a trademark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong."

The Court of Appeals considered the word "homemakers" in light of the particular type of calendars here involved, applied in the above-quoted principles of law laid down by this Court, and reached the conclusion that the word is descriptive, and therefore not capable of appropriation as a trademark. The Court did not announce any new test of descriptiveness nor did it depart from the established principles of law on this point.

THERE IS NO CONFLICT OF DECISIONS

The decision of the Court of Appeals in this case is not in conflict with any of the decisions cited in the Petition. The cases are distinguishable on their facts. In determining whether or not a word is descriptive of certain goods, this Court and other courts have taken the *ad hoc* approach to the question, since in each case a *specific* word must be evaluated in light of the *specific* goods upon which the word is used. Therefore, the fact that some other word, as applied to some other goods, is not descriptive, is not determinative of whether or not "Homemakers" is or is not descriptive of the specific calendars upon which that word is used. In this case, as in the cases cited at pages 12-13 of the Petition, the same *test* of descriptiveness was applied,

but different conclusions were reached because the marks were different and the goods involved were different.

REBUTTAL OF PETITIONER'S REASONS

Petitioner urges four reasons for the granting of the requested writ. These may be rebutted as follows:

Alleged reason one: Appellee may urge any and all parts of the record to support the decree below.

Answer: The Petition does not assert that Petitioner was denied that right by the Court of Appeals. Therefore, this is not a proper reason for granting the writ.

Alleged reason two: Proof of secondary meaning is not needed to establish validity of "suggestive" mark.

Answer: The above principle is not involved here. The Court of Appeals held that the term here involved is "descriptive". It rejected plaintiff's contention that the term is "suggestive".

Alleged reason three: The record contains ample proof that secondary meaning, if needed by "Homemakers" had been established.

Answer: *The Court of Appeals disagreed. Such disagreement with Petitioner is not ground for certiorari.* Petitioner erroneously concludes that the Appellate Court did not consider the entire record before it in finding an absence of secondary meaning, because the Court stated that in the absence of a finding of secondary meaning by the trial court, "we may assume that none existed". The Court's statement that "we *may* assume that no secondary meaning existed" is the equivalent of "we *do* assume that no secondary meaning existed" because a study of the record failed to lead to a different conclusion. It

was clearly the Appellate Court's opinion that there is not sufficient evidence to support a finding of secondary meaning, and that the trial court's opinion was to the same effect on this point. *It is plaintiff's failure to prove secondary meaning that leads to the assumption that none existed, and that is the reason for no finding of secondary meaning by the trial court* and by the Appellate Court.

The assertion (p. 11 of Petition) that 15 U.S.C. 1052(f) is applicable was first raised in Petitioner's "Reply Brief In Support of Petition For Rehearing" filed in the Court of Appeals. The Court found it lacking in merit. This section of the statute is inapplicable to the facts in this case. This section of the statute is directed *solely* to the Commissioner of Patents and provides that he *may* accept certain facts as prima facie evidence of distinctiveness, as a prerequisite to registration. The statute is permissive, not mandatory. The required facts never were presented to the Commissioner (nor to the Court) and there is no reason for presuming that had they been presented, the Commissioner would have found the mark distinctive. He may very well have found otherwise. The Court of Appeals found the mark lacking in distinctiveness.

Alleged reason four: Judicial interpretation of trademark statute.

Answer: In each of the cases cited by Petitioner under this heading the term there in issue was non-descriptive. Therefore, no proof of secondary meaning was needed. In the present case the term is descriptive, as held by the Court of Appeals. This is fatal to its validity as a trademark where a secondary meaning has not been *proved*.

Petitioner's assertion that it "created" a 12 sheet picture calendar having an "eye appeal which undoubtedly accounts for the commercial success", if true, is irrelevant, for defendant (respondent) has not been charged with copying plaintiff's (petitioner's) calendar and, as is pointed out by the Court of Appeals,

> "Plaintiff acknowledges that defendant has the right to copy the format of plaintiff's calendars and makes no claim of exclusive rights thereto".

Petitioner urges that the editorial matter on the backs of the calendar pages is of little significance (page 14 of Petition). *The Court of Appeals did not agree.* Factually, Petitioner is arguing contrary to the testimony given by its own witnesses. Petitioner's witness, Sadak, testified (Appendix, pp. 33 and 34) that he became attached to this type of calendar because

> "It had on the back of each sheet some very valuable information that the housewife appreciated in the way of cooking and so forth—different meals, recipes, and so forth."

Petitioner's witness, Durkin, testified to the same effect. (Appendix p. 44).

CONCLUSION

Where review by certiorari is sought on the basis of an alleged conflict, there must in fact be a conflict, a real and embarrassing conflict. In *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al,* 1923, 261 U.S. 387, 393, this Court held:

"it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit court of appeal."

There is no basis on which the Petition can be granted, and, accordingly, we pray that it be denied.

Respectfully submitted,

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